

**REMARKS**

This paper is filed in response to the Office Action mailed July 18, 2012 (the “Office Action”).

Following the amendments above, claims 12-15, 17, 19-23, 25, 36-40, 42-43, 58-70, 72-76, 78-82, 92-96, and 98-111, 113-116, and 120-121 are pending.

Claim 121 was rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Claims 12-15, 17, 19-23, 25, 36-40, 42, 43, 58-70, 72-76, 78-82, 92-96, 98-111, 113-116, 120, and 121 are rejected under the judicially-created doctrine of obviousness-type double patenting over U.S. Patent No. 8,072,422 to Rosenberg et al (“Rosenberg”).

Applicant has amended claim 121. No new matter is added by this rejection and support may be found in the specification and claims as originally filed.

Applicant traverses each of the bases of rejections in the Office Action and respectfully requests reconsideration and allowance of all claims in view of the amendments above and the remarks below.

I. § 101 – Claim 121

Claim 121 was rejected as allegedly claiming a pure signal computer-readable medium. Applicant has amended claim 121 to recite a “non-transitory” computer-readable medium. The USPTO has noted that computer-readable medium claims that cover “both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation ‘non-transitory’ to the claim.”<sup>1</sup> Further, the USPTO has noted that

“[s]uch an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory

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<sup>1</sup> Subject Matter Eligibility of Computer Readable Media, signed by Director Kappos on Jan. 26, 2010.

embodiment because a signal *per se* is the only viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure.”<sup>2</sup>

For the purposes of this application, the term “non-transitory” is intended to exclude transitory, propagating signals as defined in Nuijten.<sup>3</sup> The specification provides multiple examples of non-transitory computer readable media, including RAM, ROM, hard disks, etc.<sup>4</sup> Each of these is a non-transitory computer-readable medium. Further, given the USPTO’s position that (a) such an amendment obviates a rejection under 35 U.S.C. § 101, and (b) that such an amendment does not constitute the addition of new matter so long as non-transitory embodiments are disclosed, Applicant respectfully asserts that amended claim 121 is directed to patentable subject matter. Therefore, Applicant respectfully requests the Examiner withdraw the rejection of claim 121.

## II. Double Patenting

Applicant submits herewith a Terminal Disclaimer over Rosenberg to obviate the double-patenting rejection. Applicant respectfully requests the Examiner withdraw the rejection over Rosenberg.

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<sup>2</sup> *Id.*

<sup>3</sup> In re Nuijten, 500 F.3d 1346, 1352, 1357 (Fed. Cir. 2007).

<sup>4</sup> See, e.g., Specification, p. 9, lines 3-12.

**CONCLUSION**

Applicant respectfully asserts that in view of the amendments and remarks above, all pending claims are allowable and Applicant respectfully requests the allowance of all claims.

Should the Examiner have any comments, questions, or suggestions of a nature necessary to expedite the prosecution of the application, or to place the case in condition for allowance, the Examiner is courteously requested to telephone the undersigned at the number listed below.

Date:

October 18, 2012

Respectfully submitted,

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